

### **REMARKS**

Claims 1-6 were examined and reported in the Office Action. Claim 1 is rejected. New claims 7-11 are added. Claims 1-11 remain.

Applicants request reconsideration of the application in view of the following remarks.

#### **I. 35 U.S.C. §102**

It is asserted in the Office Action that claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,953,125 issued to de Groot ("de Groot "). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's amended claim 1 contains the limitations of

[a]n apparatus for shifting a reference distance of a laser displacement sensor, wherein the apparatus is mounted on the laser displacement sensor provided with a laser beam source for generating a laser beam and a laser beam reception member, the apparatus comprising: a transparent member having a refraction index being different from a refraction index of an air; and a holder for supporting the transparent member in such a way that the transparent member is placed in an optical path of the laser beam; wherein the transparent member changes a reference distance of the laser displacement sensor by changing the optical path of the laser beam.

In other words, in Applicant's claimed invention the transparent members are located between the laser displacement and the target object and each transparent member operates to change a reference distance of the laser displacement sensor.

De Groot discloses a device for performing measurement using polarized light and interferometry, where measurement is between two surfaces, where one is transparent. De Groot, however, does not teach, disclose or suggest Applicant's amended claim 1 limitations of

a transparent member having a refraction index being different from a refraction index of an air; and a holder for supporting the transparent member in such a way that the transparent member is placed in an optical path of the laser beam; wherein the transparent member changes a reference distance of the laser displacement sensor by changing the optical path of the laser beam.

Therefore, since de Groot does not disclose, teach or suggest all of Applicant's claim 1 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to de Groot. Thus, Applicant's claim 1 is not anticipated by de Groot.

Accordingly, withdrawal of the 35 U.S.C. §102 (b) rejections for claim 1 is respectfully requested.

## **II. Allowable Subject Matter**

Applicant notes with appreciation the Examiner's assertion that claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has added new independent claim 7. New claim 7 includes claim 1 in addition to the limitations of claim 2. As asserted in the Office Action, claim 2 would be allowable if rewritten in independent form. Therefore, Applicant asserts that new claim 7 is allowable. Additionally, new claims 8-11 either directly or indirectly depend on new claim 7. Therefore, new claims 8-11 are allowable for the same reason.

Applicant respectfully asserts that claims 1-11, as they now stand, are allowable for the reasons given above.

**CONCLUSION**

In view of the foregoing, it is believed that all claims now pending, namely 1-11, patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

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Dated: July 17, 2006

By: \_\_\_\_\_

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on July 17, 2006.

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Jean Szyboda